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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,228	05/02/2001	Malcolm Gibson Hodgskiss		7403

7590 11/27/2002  
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CANADA

EXAMINER

KILKENNY, TODD J

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 11/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/846,228	<b>Applicant(s)</b> HODGSKISS, MALCOLM GIBSON	
	<b>Examiner</b> Todd J. Kilkenny	<b>Art Unit</b> 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: Applicant should move the Detailed Description heading from the top of page 4 to between the first and second paragraphs of page 3. That is, only the first paragraph of page 3 should be under the heading of the Brief Description of the Drawings.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 – 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As currently written, it is unclear if applicant is claiming a method of adhesive wood joinery (i.e. a method) or the actual wood joint itself (i.e. a product). It is the current position that the applicant is attempting to claim a method of adhesive wood joinery. Therefore, the claim is recognized as lacking a transitional phrase that separates the claims preamble from its body (see MPEP §2111.03) and is further lacking any clear positive steps in the body that positively define any method steps to carry out the method. That is, if applicant is attempting to claim a method of adhesively joining individual wood elements, applicant should include a positive claim limitation

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within the body of the claim (i.e. after the transitional phrase) that defines the action taken to achieve the method (e.g. a step of applying adhesive to a wood joint).

4. Claim 2 recites the limitation "the joints" in line 1. There is insufficient antecedent basis for this limitation in the claim. That is claim 1 fails to positively define "joints"

5. Claim 3 recites the limitation "the individual wooden elements" in line 1. There is insufficient antecedent basis for this limitation in the claim. Independent claim 1 fails to positively introduce "individual wooden elements".

6. Likewise, claims 5 and 6 recite the limitation "the wooden elements" in line 1, respectively. There is insufficient antecedent basis for this limitation in the claim.

7. The term "many" in claim 2 is a relative term, which renders the claim indefinite. The term "many" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear how many different directions "many" defines. Is "three" considered many?

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1 – 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown (US 4,546,024).

Brown discloses a dynamic adhesive joinery between modular-accessible tiles, wherein the tiles may be of any commercially available material including hardwoods and softwoods (Col. 10, lines 21 – 60). The wood tile joinery comprises:

"dynamic-interactive fluidtight-elastomeric-adhesive-sealant, which provides a good adhesive bond to each tile, is flexible when cured, is capable of taking the stress inherent within the dynamic moving action for the dynamic system, and will form a non-sticky, flexible surface coating after curing." (Col. 10, line 63 – Col. 11, line 3)

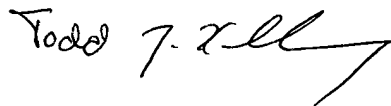
Types of adhesives include flexible urethane or polyurethane sealants. Referring to Figures 16 – 19, the joinery is complete without fasteners, joinery millwork or supporting structures and exhibits hinge-like flexibility. Brown additionally discloses that it is preferable for the tiles to be free of any direct mechanical attachment by any means, which can serve to transmit impact sound. That is, the tiles are disclosed as being joined one to another *only at all of their sides by the dynamic-interactive-fluidtight-elastomeric-adhesive-sealant bond*. (Col. 11, line 57 – Col. 12, line 14).

**Conclusion**

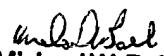
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Todd J. Kilkenny** whose telephone number is **(703) 305-6386**. The examiner can normally be reached on Mon - Fri (9 - 5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



TJK  
November 21, 2002



**Michael W. Ball**  
**Supervisory Patent Examiner**  
**Technology Center 1700**